

REMARKS

Claims 1 through 54 are pending in the application. Claims 1 through 15 are original claims, and claims 16 through 54 were previously added by amendment. No claims are amended by this Paper. Allowance of claims 1 through 15 is noted with appreciation.

Rejection of Claims 16, 17, 20, 21, 24, 26, 28, 31, 32 and 35-54 under 35 U.S.C. §251

Claims 16, 17, 20, 21, 24, 26, 28, 31, 32 and 35-54 are again rejected under 35 U.S.C. §251 as being an “improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.” Applicant respectfully traverses this rejection for the following reasons.

In support of this rejection, the Examiner asserts that,

“[a] broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that Applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. §251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.”

The Examiner’s assertion is an incorrect application of 35 U.S.C. §251, that raises several issues. Examination of these issues reveals an absence of justification for the Examiner’s application of 35 U.S.C. §251 to support this rejection.

A. The Rejections Of Independent Claims 16, 20, 24, 31, 32 and 35 Through 54 Under 35 U.S.C. §251 Is Impermissibly Based Upon Language of Dependent Claims.

First, in the application of 35 U.S.C. §251 to support this rejection of Applicant's reissue claims 16 through 51, the Examiner has argued that:

"In claims 16-51, Applicant has omitted the language 'skipping a remaining data address in said different recording locations of said data track, when any one data address mark recorded in said different recording locations is normally detected 'and' said transducer head not utilizing a remaining data address mark recorded in said different recording locations of said data track, when a data address mark recorded in a different data address regions is detected'. This language specifically added to claims in the original patent to place it in condition for allowance".

The Examiner's assertion is improper as a matter of law. The Examiner's attention is invited to the rejection, which is based upon the statute set forth in 35 U.S.C. §251, which provides that:

"Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of ... the patentee claiming more or less than he had a right to claim in the patent, the Director shall ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application"

Moreover, 35 U.S.C. §251 expressly contemplates issuing a reissue patent with claims that are broader than those issued in the patent. Specifically, 35 U.S.C. §251 states that:

"No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent"

The instant application was in fact filed within the two year window.

In the Examiner's response and argument, the Examiner argues that the Applicant's statement that "forming and processing a data address mark" defers from "a method of providing a data block", describing the step of "writing" rather than "the step of processing in address mark" is, in the Examiner's opinion, erroneous. The basis for the Examiner's disagreement is the Examiner's assertion that the phrase taken from the preamble of independent, rejected claim 16, namely "a method of providing a data block" encompasses the "processing step" defined by dependent claims 18 and 19. The Examiner is cautioned that the rejection and the examination should be of independent claim 16; any effort by the Examiner to read features from dependent claims 18 and 19 into independent claim 16, is unauthorized and impermissible. Claim 16 is an independent claim; moreover, claim 16 was presented in this application to provide a broader scope of coverage than was found in the claims of the Applicant's U.S. Patent No. 5,963,387. The fact that the scope of coverage provided by claim 16 is broader in scope, is no basis for a reissue capture rejection under 35 U.S.C. §251. Furthermore, the presence of dependent claims such as 18 and 19 which define other and additional steps of "processing" provides no basis in U.S. practice for interpreting a single preamble phrase of a patent claim. The impropriety of the Examiner's argument demonstrates its fallaciousness.

The Examiner continues to argue that the verb "providing" encompasses both "the writing as well as [the] forming and processing." It is unclear why the Examiner has made this assertion, because the verb "providing" is a single verb found in the preamble of claim 16. Any question of reissue recapture under 35 U.S.C. §251 is determined by prosecution of the patent

application, rather than misguided efforts by the Examiner to improperly read into an independent claim, features defined by claims depending upon that independent claim.

The Examiner continues in this vein by persisting in an effort to limit the scope of coverage provided by independent claim 26, based upon the Examiner's endeavor to read features defined by dependent claims 27, 29 and 30 into independent claim 26. Claim 26 stands upon its own, and its scope of coverage is interpreted broadly, unlimited by the language of claims depending upon independent claim 26. Moreover, claim 26 expressly defines a "method for reading a data block." Consequently, whether "reading" or "writing" may be characterized as "processing", the fact is the Examiner's interpretation of single verbs in independent claims 16 and 26 is pointless and unmerited by the prosecution history of this application. Attempts to limit the scope of coverage accorded to these independent claims by improperly attributing features found in their dependent claims, is contrary to statute. Questions of reissue recapture simply may not be resolved by resorting to the language of the dependent claims. Withdrawal of this line of reasoning in subsequent Office correspondence is respectfully requested.

B. The Rejections Of Independent Claims 16, 20, 24, 31, 32 and 35 Through 54 Under 35 U.S.C. §251 Is Unlawfully Based Upon A Determination Of Reissue Recapture Using The Text Of The Patented Claims.

Second, in support of this rejection, the Examiner argues that:

"the fact that applicant willingly amended the original claims 1, 7 and 11 to incorporate the language *skipping a remaining data address in said different recording locations locations of said data track, when any one data address mark recorded in said different recording locations is normally detected and said transducer head not utilizing a remaining data address mark*

recorded in said different recording locations of said data track, when a data address mark recorded in a different data address region is detected to place it [sic, them] in condition for allowance and the subsequent omission of such limitation in the reissue claims is presumed to be broadening in an aspect of the reissue claims related to surrendered subject matter. Accordingly, the reissue claims are barred by the recapture doctrine. See M.P.E.P. 1412.02 and 1412.03.”

Neither section of the *Manual* supports the Examiner's assertion. What the Examiner has overlooked is that both clauses, namely (1) *skipping a remaining data address in said different recording locations locations of said data track, when any one data address mark recorded in said different recording locations is normally detected* and (2) *said transducer head not utilizing a remaining data address mark recorded in said different recording locations of said data track, when a data address mark recorded in a different data address region is detected*, although taken from the patented claims, never appeared in a rejected claim during the prosecution history of Applicant's U.S. Patent No. 5.963.387. Therefore, the question of whether claims 1, 7 and 11 would have been patentable with a shorter or with an alternative version of either clause (1) or (2) has never been before the Applicant; consequently, the Examiner has no basis on the record before the Commissioner, to assert that Applicant “is presumed to be broadening in an aspect of the reissue claims related to surrendered subject matter. By way of example, there is no basis on the record to assert that Applicant ever faced the questions of whether claims which include process steps of (1') *skipping a remaining data address in said different recording locations of said data track* or (2') *said transducer head not utilizing a remaining data address mark recorded in said different recording locations of said*

data track would also be patentably distinguished over the prior art.

Moreover, the *Board Of Patent Appeals And Interferences* has, in its Precedential Opinion *Ex parte Eggert and Mikic*, Appeal No. 2001-0790, Serial No. 09/110,145, provided guidance to the Examining corps when reviewing the question of reissue recapture. The *Board* has ruled that:

“Thus, claim 1 (once amended) constitutes surrendered subject matter under the *reissue recapture rule*, but the issued claim does not.”

In other words, neither of Applicant’s issued claims 1, 7 or 11 “constitutes surrendered subject matter.” Accordingly, the Examiner’s reliance upon any of issued claims 1, 7 or 11 to support the reissue recapture is improper under 35 U.S.C. §251. Withdrawal of this rejection is therefore respectfully requested.

C. The Rejections Of Independent Claims 16, 20, 24, 31, 32 and 35 Through 54 Under 35 U.S.C. §251 Is Premised Upon A Factually Erroneous Interpretation Of The Prior Art.

Third, the Examiner’s interpretation of claims 16 through 51 in a misguided effort to justify reissue recapture is, as was previously explained to the Examiner, incorrect on the facts presented by the prosecution history. The Examiner’s attention is again invited to consider the two features of claims 1-15 quoted by the Examiner to describe the method steps accompanying the “processing [of] a data address mark” as defined by method claims 1 and 7, and their accompanying dependent claims 2-6 and 8-10, and the operation of the transducer head assembly 6 as controlled by microcontroller 14, as expressly defined by apparatus claim 11,

together with its dependent claims 12-15. In contradistinction to the process defined by claims 1 through 10, and apparatus claims 11 through 15, Applicant's rejected reissue claims 16 through 51 define different aspects and features of Applicant's invention, with apparatus claims directed to either the recording medium as defined by claims 20-23, 38, 39 or 40, or directed to the disk drive device as defined by claims 24, 25, 32-34, 41, 42, 43, 50, 51 and newly presented reissue claim 52. The two features of method claims 1 and 7 cited by the Examiner of "skipping a remaining data address" and the functional operational feature of claim 11 with "said transducer head not utilizing a remaining data address mark" cited by the Examiner have nothing to do with Applicant's reissue claims directed to either the recording medium or to the disk drive device itself. Either feature of "skipping a remaining address" or "said transducer head not utilizing a remaining data address mark" could not lawfully be incorporated into Applicant's apparatus claims directed to either the recording medium or the disk drive device, without creating an aggregation impermissible under the second paragraph of 35 U.S.C. §112. In short, the subject matter of method claims 1 and 7 and apparatus claim 11 of either "skipping a remaining data address" or "not utilizing a remaining data address mark" are not aspects of Applicant's reissue claims directed to the recording medium or of Applicant's reissue claims defining the disk drive device.

Turning to the reissue method claims, Applicant has presented three general categories of processes: one, a method of providing a data block defined by claims 16-19 and 35-37, and newly presented independent claims 53 and 54; two, a method of reading a data block defined by claims 26-30, 44, 45 and 46; and three, a method of preparing a memory disk defined by

independent claims 31 and 47. The features of amended patent method claims 1 and 7 define "forming and processing a data address mark", while Applicant's first group of reissue process claims 16-19 and 35-37, which define a method of providing a data block, describe the step of "writing", rather than the step of "processing a data address mark" as defined by amended patent claims 1 and 7. The second group of reissue method claims 26-30, 44, 45 and 46 define a method of reading a data block, as opposed to "processing a data address mark" as defined by amended patent process claims 1 and 7 cited by the Examiner. Applicant's third group of reissue process claims, namely independent process claims 31 and 47 describe a method of preparing memory disk with one or more recording steps, as opposed to the "processing a data address mark" defined by amended patent process claims 1 and 7 cited by the Examiner.

In summary, Applicant's reissue claims are directed to different apparatus and to different methods than those defined by independent amended patent process claims 1 and 7, or independent amended disk drive apparatus claim 11. Consequently, recapture of any subject matter surrendered by the amendment of patent claims 1, 7 and 11 is not an issue here--the subject matter of the patent claims is wholly different from the subject matter of the apparatus and method reissue claims 16-54 now pending.

Fourth, the Examiner supports this rejection under 35 U.S.C. §251 by asserting that the amendment of claims 1, 7 and 11 in Applicant's patent surrendered "the broader scope" in "the application for patent", and that the broader scope "cannot be recaptured by the filing of the present reissue application." The Examiner relies upon decisions such as *Pannu v. Storz*, 258 F.3d 1366 (Fed. Cir. 2001) and *Hester Industries, Inc. v. Stein, Inc.*, 46 USP2d 1641 (Fed. Cir.

1998) to buttress the Examiner's assertion. In Paper No. 5 issued on the 30th of December 1998, the Examiner rejected claims 1, 7, 11 and 12 under 35 U.S.C. §102(b) as anticipated by Gold '545. Subsequently, in Applicant's responsive amendment filed on the 29th day of March 1999, Applicant "amended the independent claims 1, 7, and 11 to incorporate feature of allowable claims 2, 8, and 13, respectively." Additionally, Applicant expressly noted that there was no anticipation under 35 U.S.C. §102(b) "unless all of the elements of a claim are found in exactly the same situation and united in the same way in a single prior art reference, and thus every element must be literally present and must also be arranged as in the claim", (See Paper No. 6, Pg. 8, and then explain that the Examiner "appears to be misapplying the facts to Gold '545 here" because "the first address mark (AM) is included within the ID header 22 and is not considered to be a *data* address mark" while the "second address mark (AM) is included within the *data* header 24 is considered to be a *data* address mark." Applicant concluded the explanation of a lack of anticipation by explaining to the Examiner that "Gold '545 does not teach or suggest a recording of a data address mark in two locations, as set forth in Applicant's independent claims 1, 7, and 11." Applicant's remarks, amendment of 29 March 1998, pg. 8. In summary, Applicant (i) made no surrender of the subject matter of the pending reissue claims, (ii) identified the impropriety of the Examiner's anticipation rejection, and (iii) in compliance with 37 CFR. §1.111(a) and (b), pointed out the specific distinctions that rendered those claims patentable over Gold '545. The fact that Applicant identified the Examiner's misapplication of the facts of Gold '545 does not constitute surrender of either the scope or breadth of the subject matter defined by claims 1, 7 and 11. Applicant presented no argument

in the demonstration of the Examiner's misapplication of Gold '545 that the amendment itself patentably distinguished any of the amended claims over Gold '545. Applicant instead presented a factual basis for the impropriety of the anticipation rejection of those claims based upon the language of claims 1, 7 and 11 as rejected. Consequently, there was neither argument nor amendment to narrow the scope of claims 1, 7 and 11 in order to overcome the prior art. Absent argument and amendment to overcome the prior art, there is no surrender. Amendment of claims 1, 7 and 11 for reason other than an effort to overcome the prior art is irrelevant in applying the doctrine of reissue recapture.

Specifically, in Paper No. 6 Applicant explained that although the Examiner had argued in Paper No. 5 that Gold '545 "teaches recording a data address mark in at least two different locations of the data track (fig. 1A)," the Examiner appeared to be inaccurately reading Gold '545 because in FIG. 1A of Gold '545, the first address mark (AM) is included within the *ID* header 22 and is not considered to be a "data" address mark. The second address mark (AM) is included within the *data* header 24 and is considered to be a "data" address mark. In conclusion, Gold '545 does not teach or suggest a recording of a data address mark in two locations, as set forth in the applicant's independent claims 1, 7, and 11.

There is no anticipation under 35 U.S.C. §102 unless all of the elements in a claim are found in exactly the same situation and united in the same way in a single prior art reference, and thus every element must be literally present and must also be arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d

1382, 165 USPQ 494, 496 (CCPA 1970), and the *Manual of Patent Examining Procedure* (M.P.E.P.) 2143.03. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986). See also M.P.E.P. 2131 and 35 U.S.C. 102.

To establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a reasonable expectation of success. **Third**, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See the Manual of Patent Examining Procedure (M.P.E.P.) 2143 and 35 U.S.C. 103. Applicant also explained that if the Examiner fails to establish a *prima facie* case, the rejection is improper under such exemplars as *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In short, in the Remarks accompanying the Amendment, Applicant explained that Gold '545 did not set forth the each and every element of the claims 1, 7, and 11, as amended, and that thus, Gold '545 did not anticipate the applicant's claims, as amended, and therefore Gold '545 can not support a rejection under 35 U.S.C. §102. In addition, Applicant explained that Gold '545 did not teach or suggest the features set forth in applicant's claims, such as the two *data address marks* and the skipping of one data address mark. Thus, Gold '545 could not

support a rejection of claims 1, 7 and 11. These explanations of the failings in the prior art simply demonstrate that absence of a *prima facie* showing of anticipation under the all elements rule, and do not create a surrender of Applicant's right to broader coverage than that provided by patent claims 1, 7 and 11. Consequently, absent surrender, the condition precedent to invocation of the doctrine of reissue recapture does not exist; withdrawal of this rejection is therefore required.

Objection of Claims 18, 19, 22, 23, 25, 27, 29, 30, 33 and 34

Claims 18, 19, 22, 23, 25, 27, 29, 30, 33 and 34 are objected to for dependency upon a rejected base claim, but the Examiner stated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The impropriety of the Examiner's attempt to justify a statutory rejection of independent claims, based upon the language of claims dependent upon the independent claims, should, by now, be readily understood by the Examining corps. The examination of each independent claims must proceed wholly separately from the examination of any claims dependent thereon.

Moreover, the Examiner seems to have ignored the guidance kindly provided by the special efforts of the Board of Patent Appeals and Interferences as may be found in, by way of example, the precedential *Ex parte Daniel M. Eggart, et al.*, Appeal No. 2001-0790, Serial No.

09/110,145, decided on the 29th of May 2003. That Opinion is available for the Examiner's guidance. As explained in that Opinion, when the Applicant's claim 1 was "met by a final rejection", the Applicant had two options: "appeal the Examiner's final rejection" or "amend that claim in an attempt to define narrower, patentable subject matter." The Applicant in that Opinion "chose the latter option and amended claim 1 a second time" and, "upon consideration of claim 1 (twice amended), the Examiner determined that it was patentable." As further explained by the Board in *Eggert*,

"due to the vagaries of using words to describe a mechanical object ... it is not unreasonable to conclude that errors can be made in choosing the most correct language to define the mechanical object in a way which is consistent with the invention described in the patent application and is patentable over the prior art."

Thus, under 35 U.S.C. §251,

"a patentee who believes he has claimed less than he has a right to claim in the patent through error without any deceptive intent may file an application for a reissue application."

In its *Eggart* Opinion, the Board explained that the Applicant had never conceded that the broader scope of coverage provided by the reissue claims was unpatentable. Similarly, in the instant application and in the parent application, Applicant has never maintained and has advanced no action to suggest during the prosecution of the parent application that the difference in scope of coverage between the patent's issued claims and reissue claims 16 through 54, was "unpatentable." As explained by the Board, "therefore, in our view, such subject matter is not barred by the recapture rule. In short, the absence of "skipping a remaining data address" and "said transducer head not utilizing a remaining data address mark" in the

rejected reissue claims is irrelevant to the question of reissue recapture, where as in the Eggart Opinion, Applicant here simply chose to present amended claim 1 in view of the Examiner's earlier indication of the allowability of dependent claim 2. Consequently, the requisite basis for a reissue recapture under 35 U.S.C. §251 is lacking. Withdrawal of this rejection is therefore respectfully requested.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections and objections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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